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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/522,341 | 03/09/2000 | David Leigh Donoho | UNIV0001 | 3293 |

22862 7590 11/13/2006

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| EXAMINER |
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WINDER, PATRICE L

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| ART UNIT | PAPER NUMBER |
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2145

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,341

Applicant(s)

DONOHO ET AL.

Examiner

Patrice Winder

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
4a) Of the above claim(s) 16-23 and 35-44 is/are withdrawn from consideration.
5) ☒ Claim(s) 1-15 and 24-34 is/are allowed.
6) ☒ Claim(s) 45-46 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Tso et al., USPN 6,047,327 (hereafter referred to as Tso).

3. Regarding claim 45, Tso taught in a system including an advice consumer for gathering broadcast information from a communications medium and a reader associated with said advice consumer for determining relevance of said broadcast information (abstract), a communications system comprising:

an advice provider which broadcast information over a communications medium to target situations based on an advice profile [similar to claim 1 of pervious action] (column 13, lines 45-53);

wherein said advice consumer is advised of said information only if said information meets certain predetermined relevance criteria as a result of a relevance evaluation performed by said reader (column 10, lines 41-47);

wherein said advice provider broadcasts highly targeted advice the relevance of which to an advice consumer is determined by said reader without comprising individual

privacy and without learning of identity and attributes of said advice consumer (column 13, lines 59-64, column 21, lines 35-51); and

wherein said environment includes data of a sensitive or private nature (column 21, lines 33-51); and

wherein said relevance evaluation optionally occurs in an environment that is remote from that of said advice consumer (column 21, lines 52-60).

4. Regarding dependent claim 46, Tso taught data about an advice consumer is automatically inferred from other facts to produce a statistical inference that a certain conditions hold, even though said advice consumer has not input said data and said data have not been measured (column 13, lines 29-34).

Response to Arguments

5. Applicant's arguments filed August 28, 2006 have been fully considered but they are not persuasive.

6. Applicant argues – “Thus, Tso does not disclose or suggest providing targeted information to users without requiring that the users disclose private profile data, as recited by claim 1”.

a. Claim 45 recites an “environment” includes sensitive or private data.

Applicant argues that the “user profile” contains private data. The “environment” is not synonymous with “user profile”.

7. Applicant argues – “Applicant respectfully notes that the Examiner offers no explanation for the rejection of claims 45-46. Applicant believes claims 45 to be allowable for reasons similar to those concerning claim 1.

b. In paragraph #2 of the prior Office Action, the statute for rejection is identified for claims 45-46. Any remaining claims that were not explicitly addressed were summarily addressed in paragraph #13, the omission of claims 45-46 was a typographical error.

Allowable Subject Matter

8. Claims 1-15, 24-34 are allowed.

9. The following is an examiner's statement of reasons for allowance:

Claims 1-15, 24-34 are allowable over the prior art of record because the prior art fails to teach or suggest a computer communications system for providing advice consumers with targeted information without requiring the disclosure of private profile data as recited in the claims and argued by Applicant on August 28, 2006. In the communications system defined by Applicant's claim language, the prior art of record fails to teach or suggest that at least one reader can access included profile information describing advice consumers for whom received information is target, the reader running on a client advice consumer computer, at least one content provider and at least one advice site cannot access any user profile of any client advice consumer computer, and the user profile contains private data.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. Claims 16-23 and 35-44 are withdrawn.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

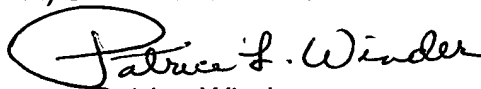
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Patrice Winder
Primary Examiner
Art Unit 2145

November 9, 2006